

09/426,063GEDP106USREMARKS

Claims 1-9 and 39-53 are currently pending in the subject application and are presently under consideration. Claims 40, 47, 50, and 51 have been amended herein to recite various novel aspects of independent claim 1. New claims 52 and 53 have been added, support for which can be found at least at page 10, line 26 through page 11, line 19 and FIGS. 4a-4c of applicant's disclosure. New claim 54 has also been added, support for which can be found at least at page 8, line 27 to page 9, line 4. A complete listing of all claims can be found at pages 2-7 of this Reply.

Favorable reconsideration of the subject patent application is respectfully requested in view of the comments and amendments herein.

I. Rejection of Claims 1-8 and 39-51 Under 35 U.S.C. §103(a)

Claims 1-8 and 39-51 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Ogasawara (US 6,868,392). Withdrawal of this rejection is respectfully requested for at least the following reasons. Ogasawara fails to disclose, teach or suggest each and every feature set forth in the subject claims.

To reject claims in an application under §103, an examiner must establish a *prima facie* case of obviousness. A *prima facie* case of obviousness is established by a showing of three basic criteria. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. *Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.* See MPEP §706.02(j). The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. See *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991) (emphasis added).

Applicant's claimed invention relates, among other things, to a multiple criterion buying and selling model that can correlate criteria defined by a buyer with the criteria defined by the sellers. The model can allow certain threshold criteria to be pre-selected prior to negotiating. (See pg. 8, line 27 – pg. 9, line 4). Thus, rather than waiting for sellers to determine if they can meet all buying criteria, deals that match threshold criteria can be output in real time, and sellers

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can be informed of criteria that does not match. For example, the sellers of a particular good or service can define a set of minimum inputs and other criteria (*see page 11, lines 4-7; page 16, lines 15-21; Fig. 8b, element 303*), while the buyers can enter criteria that is important to them, of which the sellers may not have listed in their own criteria, or even be aware it would be of interest to buyers (*see page 2, lines 24-25*). Hence, the model can inform sellers of buyers' input criteria that the sellers did not list as their own criteria (*see page 11, lines 13-15*), and output deals in real time. In particular independent claim 1 (and similarly independent claims 40, 47, 50, and 51) recites, "*correlating the deals* for at least one of a product and service *offered by the at least one seller* to the price and non-price *buying criteria inputted by a buyer*; *notifying the seller* of the particular product or service *when the buying criteria does not match the seller criteria*; and outputting a list of deals *in real time* from amongst the plurality of deals that match the buying criteria of the buyer." Ogasawara does not teach or suggest these features.

Rather, Ogasawara relates to selecting appropriate retailers from a database that offer the item or service in which a customer is interested. (*See abstract*). However, Ogasawara does not teach or suggest 1) outputting a list of deals *in real time* from amongst the plurality of deals that match the buying criteria of the buyer; 2) *correlating the deals ... offered by the at least one seller* to the price and non-price *buying criteria inputted by a buyer*; or 3) *notifying the seller* of the particular product or service *when the buying criteria does not match the seller criteria*. Instead, Ogasawara is directed toward identification of retailers that offer the merchandise and/or services sought by a customer (*see col. 12, ll. 27-28*), thus, mitigating the need for customers to perform Web searches for appropriate retailers (*see col. 4, ll. 54-55*).

In particular, Ogasawara discloses that an electronic shopping assistant (ESA) receives a customer purchase request including the customer's name, item requested, and conditions sought. (*See col. 8, ll. 6-11*). This invokes a search routine to determine the category of product in which the customer is interested. (*See col. 8, ll. 40-45*). Once the appropriate category is found, the retailer database is searched to locate those retailers with products that match the item specified by the customer. (*See col. 8, ll. 45-49*). A request for proposal (RFP) is sent to the matching retailers (*see col. 8, ll. 50-55*), who determine if they can satisfy the conditions of the customer, and, if so, subsequently send their proposals back to the ESA within the time specified by the customer (*see col. 9, ll. 19-21*), such as "in one week" (*see col. 5, ll. 47-48*). Once the identified

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retailers respond to the RFP, all proposals are bundled into *a single record* which is transmitted back to the customer. (*See* col. 10, ll. 9-12).

- a. *Ogasawara does not teach or suggest outputting a list of deals in real time from amongst the plurality of deals that match the buying criteria of the buyer.*

Most particularly, all proposals from the identified retailers are compiled into *a single record* by the ESA prior to being transmitted to the customer who made the purchase request. Since Ogasawara is concerned with identifying the retailers that can cater to specific buyer needs and requirements, whatever they may be (*see* col. 6, ll. 53-54; *see also* col. 4, ll. 57-59; col. 9, ll. 39-41), the ESA must therefore allow the retailers the time and opportunity to tailor their proposals. Accordingly, the ESA must wait the maximum amount of time before compiling the proposals and sending them to the customer who made the purchase request. Otherwise, the ESA could not be assured that all relevant proposals are included, *e.g.*, very well crafted ones that are specifically tailored to the buyer's needs but are received just before the deadline. Thus, outputting a list of deals *in real time* from amongst the plurality of deals that match the buying criteria of the buyer is not an object of Ogasawara.

The reference is not only silent as to these features, it expressly teaches away from outputting a list of deals *in real time* in favor of providing a weeks' time before outputting the recommended proposals to the customer who made the purchase request. The Federal Circuit has held that teaching away from the claimed subject matter is a *per se* demonstration of lack of *prima facie* obviousness. *In re Dow Chemical Co.*, 837 F.2d 469, 5 USPQ2d 1529 (Fed. Cir. 1988). Accordingly, the Examiner has failed to present a *prima facie* case of obviousness and this rejection of independent claims 1, 40, 47, 50, and 51, as well as all claims that depend therefrom, should be withdrawn.

- b. *Ogasawara does not teach or suggest correlating the deals for at least one of a product and service offered by the at least one seller to the price and non-price buying criteria inputted by a buyer.*

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Additionally, Ogasawara does not teach or suggest *correlating the deals ... offered by the at least one seller* to the price and non-price *buying criteria inputted by a buyer*. Rather, the ESA only identifies retailers that actually *offer the requested goods or services*, irrespective of any of *buying criteria inputted by a buyer*. (See col. 4, ll. 26-28). Hence, at most, Ogasawara teaches that *the product or service* specified by the customer can be correlated to *retailers*. It is left up to the retailers themselves to ascertain whether or not they can satisfy the conditions specified by the customer, and, if so, those retailers may submit a proposal. That is, even in the case where the retailer can meet these conditions, there is no *correlating the deals ... offered by the at least one seller* to the price and non-price *buying criteria inputted by a buyer*.

Although Ogasawara teaches that the proposals can be filtered by the Proposal Analysis Engine, this process looks at the proposals from the retailers (e.g., criteria inputted by the *seller*), not the criteria inputted by a *buyer*. (See col. 10, line 61 – col. 11, line 13). Accordingly, Ogasawara does not teach or suggest all the claimed features, and this rejection should be withdrawn.

c. *Ogasawara does not teach or suggest notifying the seller of the particular product or service when the buying criteria does not match the seller criteria.*

The Examiner concedes at page 2 of the Office Action (dated April 18, 2006) that Ogasawara does not disclose *notifying the seller* of the particular product or service *when the buying criteria does not match the seller criteria*, but takes Official Notice that notifying sellers of when a product or service criteria does not match the buyer criteria has been common knowledge in the product/service commerce art. Applicant's representative respectfully traverses the aforementioned well-known statements and request that the Examiner cite a reference in support of her position pursuant to MPEP 2144.03 if the rejection of the claims is to be maintained. Moreover, the Official Notice is moot in combination with Ogasawara.

As detailed *supra* in section b., the ESA does not examine the buying criteria in order to identify retailers, but instead examines which category of product or service is being requested by the buyer. Since the ESA does not know whether the identified retailers can match these criteria, it cannot be suggested that the ESA could notify the seller when there is no match. Rather, by submitting a proposal the *sellers* (e.g., retailers) implicitly notify the *ESA*, not the

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other way around. Moreover, by submitting a proposal that matches the buying criteria, the seller is (at most) notifying the ESA of *matches*, not of criteria that *does not match*, as recited in the subject claims. In sum, even if, as the Examiner alleges, notifying the seller of the particular product or service when the buying criteria does not match the seller criteria were well known, such a well known aspect could not be applied to Ogasawara. That is, Ogasawara cannot be construed to convey information (e.g., notifying the seller) of which the reference has no ability to know. Therefore, even if *conveying* this information were well known, it cannot be properly applied to a reference that has no ability to determine the information in the first place. Hence, the Official Notice is moot.

For at least the foregoing reasons, the Examiner has failed to make a *prima facie* case of obviousness *vis-à-vis* the subject claims. Accordingly, this rejection of independent claims 1, 40, 47, 50, and 51, as well as all associated dependent claims, should be withdrawn.

II. New Claims 52-54

New claims 52-54 have been added for consideration and include limitations similar to one or more claims filed with the application; and, thus, do not raise issues requiring further search or effort on behalf of the Examiner. These claims further emphasize various novel aspects, support for which can be found at least at page 8, line 27 to page 9, line 4 and page 11 and FIGS. 4a-4c of applicant's disclosure, and, in light of the comments herein are believed to be allowable.

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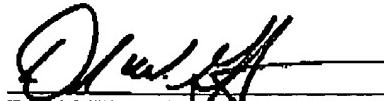
The present application is believed to be in condition for allowance in view of the above comments and amendments. A prompt action to such end is earnestly solicited.

In the event any fees are due in connection with this document, the Commissioner is authorized to charge those fees to Deposit Account No. 50-1063 [GEDP106US].

Should the Examiner believe a telephone interview would be helpful to expedite favorable prosecution, the Examiner is invited to contact applicant's undersigned representative at the telephone number below.

Respectfully submitted,

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